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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

A1M1/1201

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ART UNIT	PAPER NUMBER
1112	6

DATE MAILED: 12/01/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-37 are pending in the application.
   Of the above, claims 17-37 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 1-16 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 21-16, drawn to a method, classified in class 427, subclass 562.

II. Claims 17-28, drawn to an article, classified in class 428, subclass 694TC.

2. III. Claims 29-33, drawn to a method, classified in class 250, subclass 424.

3. IV. Claims 34-37, drawn to an apparatus, classified in class 118, subclass 723FI.

4. The inventions are distinct, each from the other because:

5. Inventions I and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus or claimed can be used to practice another and materially different process such as forming a plasma containing ions of boron and depositing on a substrate.

6. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a magnetic head slider.

7. Claim I and III are not directly related.

8. Inventions IV and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the apparatus as claimed is not an obvious apparatus for washing the product and the apparatus as claimed can be used to make a materially different product such as a magnetic head slider or a drill but with a near resistant coating.

9. Claim II and III are not directly related.

10. Claim III and IV are not related since inventor III is a method of improving a process while invention IV is an apparatus per se.

11. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications restriction for examination purposes as indicated is proper.

12. During a telephone conversation with Mark Barrish on 11-19-97 a provisional election was made with traverse to prosecute the invention of I, claims 1-16. Affirmation of this election must be made by applicant in responding to this Office action. Claims 17-37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grill et al in view of Rabalais et al.

The primary reference, Figure 3, and col. 2, lines 30-35 discloses a method of making a magnetic recording device comprising applying a diamond like carbon protective coating on to a magnetic recording layer by plasma deposition. The primary reference fails in anticipation of these claims in that it does not disclose application of a diamond layer. Rabalais the abstract discloses application of a diamond protection layer by ion deposition. It is the examiner's opinion that it would have been obvious for one having ordinary skill in the coating art at the time the invention was made to substitute the diamond protective coating of Rabalais et al for the diamond protective coating of Grill since Rabalair teaches this to be known in the coating art for protecting surfaces. Also the limitation of the dependent claims are conventional and do not render these claims unobvious.

Any inquiry concerning this communication should be directed to B. Pianalto at telephone number (703) 308-2332.

B. Pianalto:rg
November 28, 1997

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PRIMARY EXAMINER
GROUP 1100